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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/603,644

06/25/2003

James D. Burrington

3215

2753

26645

7590

08/20/2008

THE LUBRIZOL CORPORATION
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EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/603,644	Applicant(s) BURRINGTON ET AL.	
	Examiner Ellen M. McAvoy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008 and 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08 January 2008; 05 May 2008</u> . | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(1) Claims 1, 2, 5-20 and 22-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 11/456,932. Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant additive gel and process for lubricating mechanical devices comprising supplying one or more lubricant additive gels to the lubricant in the copending application may contain the same components as the claimed gel compositions and may also have a tan delta value of less than 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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(2) Claims 1, 2, 5-20 and 22-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5-9, 11-21 and 28 of copending Application No. 11/506,298. Although the conflicting claims are not identical, they are not patentably distinct from each other because the gel compositions comprising one or more fuel additives in the form of a gel and process of contacting the gel compositions with the combustion chamber of an engine of the copending application may be the same as the claims in this application. Although it is recognized that lubricant and fuel compositions are distinct, the compositions of the co-pending application do not require the addition of a fuel and may contain the same components, namely a dispersant, a detergent and an antioxidant.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(3) Claims 1, 2, 5-20 and 22-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 11/557,508. Although the conflicting claims are not identical, they are not patentably distinct from each other because the control release gels and processes of contacting the gels with a lubricant in a device of the copending application may be the same as the claims in this application since the components of the gel may be the same and may be used in the same processes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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(4) Claims 1, 2, 5-20 and 22-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 12/128,042. Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant additive package comprising one or more lubricant additives in the form of a slow release gel and processes of using the slow release gels of the co-pending application may contain the same components as the claimed gel compositions, may be used in the same way and the gel compositions may also have a tan delta value of less than 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(5) Claims 1, 2, 5-20 and 22-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,384,896. Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant additive gel and process for lubricating mechanical devices comprising supplying one or more lubricant additive gels to the lubricant in the patent may contain the same components as the claimed gel compositions and may be used in the same process.

The rejection of claims 1, 2, 5-20 and 22-24 under 35 U.S.C. 103(a) as being unpatentable over Higton et al (6,310,010) made in the previous office action is withdrawn in view of the amendments to the independent claims 1, 11 and 22 that the compositions have a tan delta value of less than or equal to 0.75. In the Declaration under 37 C.F.R. §1.132 by inventor

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James Burrington filed 05 May 2008 it is stated that the gel compositions of the present invention are significantly different from the sometimes viscous liquids described in the applied prior art reference to Higton et al (U.S. Patent No. 6,310,010) including those liquids that experience the “large” Weissenberg effect described by the reference. In support of this statement, seven examples were prepared and tested. In Figure 1, the inventive samples have significantly higher rotational viscosity values that reach up well above 10,000 Pa.s and continue to bounce with sharp spikes that do not level out over time. In contrast, the gels in Higton that experience the Weissenberg Effect do experience an increase in viscosity which raise to over 100 Pa.s but which then level off and do not rise over 1000 Pa.s. The Declaration states that these differences in rotational viscosity profiles clearly demonstrates the fundamental differences between the viscous liquids referred to as “gels” in Higton and the solid-like fluid additive gels of the present invention.

In addition, Table 3 in the Declaration shows that the inventive samples have storage modulus values >100 while all of the other samples, including the “large Weissenberg Effect” samples from Higton have storage modulus values >20 . Table 3 also demonstrates tan delta values of 0.22 and 0.15 for the inventive samples and tan delta values of 0.94, 1.11 and higher for the samples from Higton. Thus the examiner agrees that all of these differences demonstrate that the samples in Higton, though viscous and impacted by the Weissenberg Effect, are not “gels” in the sense of the term used in the present invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/

Ellen M McAvoy
Primary Examiner
Art Unit 1797

EMcAvoy
August 18, 2008